



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,023	03/18/2004	Hirokazu Ikeda	16869K-111100US	9205
20350	7590	05/10/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				NGUYEN, TAN D
		ART UNIT		PAPER NUMBER
		3629		

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/805,023	IKEDA ET AL.
	Examiner	Art Unit
	Tan Dean D. Nguyen	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION***Response to Amendment***

The amendment filed 1/17/06 has been entered. Claims 1-20 are pending and are rejected as followed.

Claim Rejections - 35 USC § 112

1. Claims 15, 1-7, 16-17, 8-14, 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Method claim 15 calls for “a controlling method of an information processing device” in the preamble but fails to discuss the body of the claim how the controlling steps for the device is carried out. The body of the claim 15 only discuss about the information processing system. Also, in claim 15, the phrase “receiving parameters for said processes” on lines 7, 13, 14 appear to be vague and should be corrected to “parameters settings”. Also, the last two lines, lines 13-14 of claim 15, is vague and indefinite because the phrase “when said parameters are set to said processes defined in said policies” is vague.

2. Claims 1, 8 or 15 recites the limitation "said processes" in line 7 or 8. There is insufficient antecedent basis for this limitation in the claim.

Similarly, claims 1-7, 16-17, 9-14, 18-20 are rejected for the same reason set forth in claim 15 above.

Claim Objections

3. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how the features of the information processing system further limits the steps of: (a) storing a control strategy ..., (b) receiving parameters ..., and (c.) changing said parameters.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. **Claim 15 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over AHLSTROM et al (US patent 6,327,618).**

As for independent method claim 15, which deals with a method for controlling an information processing system {see Fig. 2A}, comprising the steps of:

- (a) storing a strategy of the information processing system including a provision to policies each of which defines a process to be executed in the system, wherein the strategy is a control (precedent) strategy {see col. 3, lines 40-50},
- (b) receiving parameters for said processes {see col. 3, lines 40-50}; and
- (c.) changing said parameters so that said policies meet the control (precedent) strategy when said parameters are set to said processes defined in said policies" {see col. 5, lines 34-35, col. 9, lines 14-18, or lines 30-36}. Alternatively, the use of similar or equivalent term to describe the strategy, i.e. control or precedent or master policy,

would have been obvious to a skilled artisan as mere using other well known equivalent term, absent evidence of unexpected results.

9. Claims 8-14, 18-20 (apparatus), and 1-7, 16-17 (medium) are rejected under 35 U.S.C. 103(a) as obvious over AHLSTROM et al.

As for independent apparatus claim 8, AHLSTROM et al discloses an information processing device included in an information processing system comprising:

(b) an input receiver configured to receive a parameter (input or entry or data or information) entered {see Fig. 3, (314)},

(c) a parameter (input or entry or data or information) changer configured to change the parameter {see col. 3, lines 43-61, col. 12, lines 16-60}. As for the limitation of (a) “a global policy table configured … system”, and “a parameter changer configured to change”, this carries no patentable weight because this is merely intended use of the parameter or further limiting the object of the element “input receiver” and not the element “input receiver” itself. A parameter is not an element or elemental structure of the device, thus carrying no patentable weight in an apparatus claim. A policy, policy set, or policies are merely objects or function and are not elements or elemental structures of the device, thus carrying no patentable weight in an apparatus claim. Note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F. 3d 1473, 1477-1478, 44 USPQ2d 1429, 1431-1432 (Fed. Circuit 1997). See MPEP 2114 [R-1]. Note: See claim 25, col. 36, of FRIEDRICH et al for a typical demonstration of a proper apparatus

claim. Moreover, this is mere the system to carry out the method of independent method claim 15 above, and it's rejected over the apparatus of AHLSTROM et al, as shown in Figs. 3, 2A, 2C, to carry out the rejection of claim 15 as cited above.

Alternatively, the use of similar or equivalent term to describe the strategy, i.e. control or precedent or master policy, would have been obvious to a skilled artisan as mere using other well known equivalent term, absent evidence of unexpected results. Also, the use of any other form of policy element configuration, i.e. table or phrase or format, would have been obvious to a skilled artisan as mere using other type of format, forms or configuration to achieve similar results, absent evidence of unexpected results. Note, that this is considered as "various immaterial modifications within the same scope", as mentioned by AHLSTROM et al on col. 14, lines 12-17.

As for dependent claim 9 (part of 8 above), which deals with well known computer parameters, i.e. a back up device for saving a duplicate of data stored in the storage device for the well known purpose of avoiding loss of data, it would have been obvious to a skilled artisan to do so to provide back up system in case of data loss.

As for dependent claim 10-11 (part of 8 above), further deals with limitations related to parameter or policy, policies, or set of policies mentioned above, thus carrying no patentable weight as described above. Only elements related input receiver or parameter changer receive patentable weight. Moreover, these are fairly taught in col. 6-8 of AHLSTROM et al. Moreover, the selections of other processes, or policies, etc., would have been obvious to a skilled artisan as mere selection of other similar policies

to achieve similar results or “various immaterial modifications within the same scope”, as mentioned by AHLSTROM et al on col. 14, lines 12-17.

As for dependent claims 12-13 (part of 8 above), further deals with functions limitations of the parameter charger, i.e. “*calculates a ... value*”, and this has no patentable weight since no elemental structures have been shown. Moreover, these are fairly taught in col. 6-8 of AHLSTROM et al. Moreover, the selections of other processes, or policies, etc., would have been obvious to a skilled artisan as mere selection of other similar policies to achieve similar results or “various immaterial modifications within the same scope”, as mentioned by AHLSTROM et al on col. 14, lines 12-17.

As for dependent claims 14, 19-20 (part of 8 above), which deals with further limitation of the “parameter” “for specifying said policies ...” “setting policies”, this carries no patentable weight because this is merely intended use of the parameter or further limiting the object of the element “input receiver” and not the element “input receiver” itself. A parameter is not an element or elemental structure of the device, thus carrying no patentable weight in an apparatus claim. A policy, policy set, or policies are merely objects or function and are not elements or elemental structures of the device, thus carrying no patentable weight in an apparatus claim. Note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See In re Schreiber, 128 F. 3d 1473, 1477-1478, 44 USPQ2d 1429, 1431-1432 (Fed. Circuit 1997). See MPEP 2114 [R-1]. Moreover, these are fairly taught in

col. 6-8 of AHLSTROM et al. Moreover, the selections of other processes, or policies, etc., would have been obvious to a skilled artisan as mere selection of other similar policies to achieve similar results or “various immaterial modifications within the same scope”, as mentioned by AHLSTROM et al on col. 14, lines 12-17.

As for dependent claim 18 (part of 8 above), further deals with functions
limitations of the parameter charger, i.e. “*uses said acquired operation performance information*”, and “*control strategy*”, these have no patentable weight since no elemental structures have been shown. Moreover, these are fairly taught in col. 6-8 of AHLSTROM et al. Moreover, the selections of other processes, or policies, etc., would have been obvious to a skilled artisan as mere selection of other similar policies to achieve similar results or “various immaterial modifications within the same scope”, as mentioned by AHLSTROM et al on col. 14, lines 12-17.

As for independent product claim 1, which is a computer-readable medium
containing a computer software program for causing a computer to perform the steps of claim 15 above, it’s rejected over the computer-readable medium of AHLSTROM et al to carry out the method of claim 15 as rejected above and further in view of “computer readable medium” as shown on col. 13, lines 18-34.

As for dependent claims 2-4, 5-7, 16-17 (part of 1 above), which have the same limitations respectively as in dep. claims 9-11, 12-14, 18-19 (part of 8 above),
they are rejected for the same reasons set forth in the rejections of claims 9-11, 18, 12-14, 19 above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,651,191 by Vacante et al. discloses a method for testing a policy parameter (global setting and local setting), determining the conflict, and resolving the conflict, as shown on cols. 3-6, which is similar to the teachings of AHLSTROM et al above. It's cited for applicant' awareness for potential use in the future if needed.

Response to Arguments

12. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

Art Unit: 3629

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

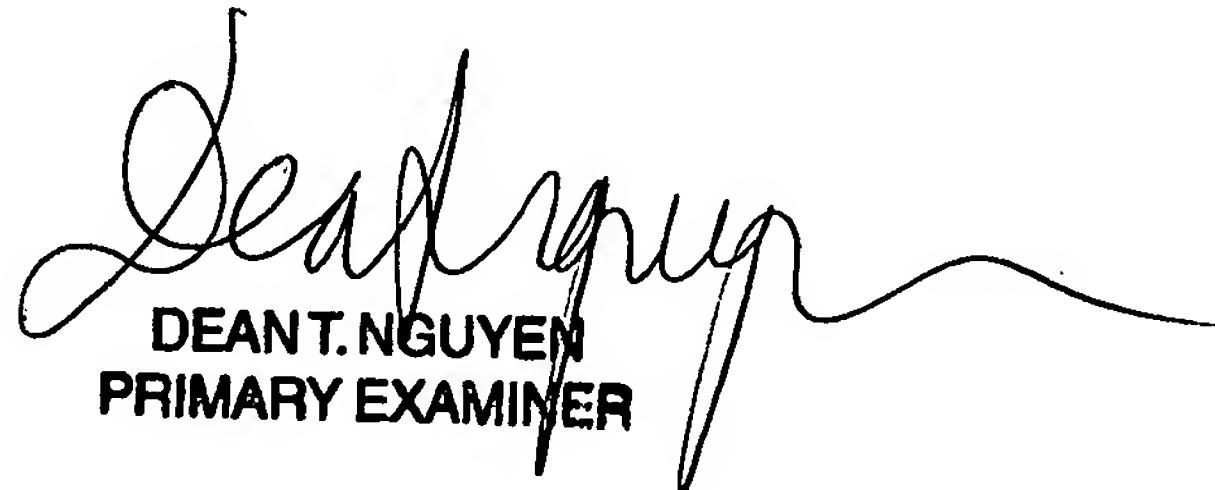
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
May 8, 2006



DEAN T. NGUYEN
PRIMARY EXAMINER